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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JON MARCUS RANDALL WHITTEN and
CHRISTOPHER M. PIRICH

Appeal 2008-4255
Application 09/802,797
Technology Center 3700

Decided:¹ May 5, 2009

Before JAMES D. THOMAS, JAY P. LUCAS, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, J., *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 18, 20 through 35, 57, 58, 60, and 69 through 71. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants have invented a gaming system that includes a hard disk drive for storing applications and other data on respective, multiple regions of this drive. An application executing on the gaming system prevents a particular application from accessing data in an area of the hard disk drive that is not associated with that particular application (Spec. 41, Abstract; Figures 2 and 4).

Representative Claim

18. A game console comprising a processor and a hard disk drive coupled to the processor, wherein the hard disk drive stores a console application to which the game console boots, and wherein the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other applications.

Prior Art and Examiner's Rejections

The Examiner relies on the following references as evidence of unpatentability:

Smith	U.S. 6,599,194 B1	Jul. 29, 2003 (filed Apr. 8, 1999)
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Microsoft Corporation, *Getting Started Windows98, Second Edition*, 80-81, 87-90 (1998) (hereinafter "Windows 98").

Access Software, Inc., *Links 386 CD Players Manual*, 1-87 (1995) (hereinafter "Links").

All claims on appeal, claims 18, 20 through 35, 57, 58, 60, and 69 through 71 stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 18, 20 through 25, 27 through 35, 57, 58, 60, and 69 through 71, the Examiner relies upon Smith in view of Windows 98 in a first stated rejection. In a second stated rejection, the Examiner further relies upon Links in addition to the initial combination of references as to claims 26, 32, and 33.

A double patenting rejection has been set forth by the Examiner at pages 10 and 11 of the Answer that has not been set forth in the Final Rejection mailed on November 13, 2006. Pages 2 and 3 of this rejection set forth by incorporating by reference to a previous Office Action, the identical prior art rejections presented in this Answer but fail to incorporate by reference the double patenting rejection made in this prior Office Action, which was a non-final Office Action mailed on November 16, 2005. Since this rejection was not repeated in the Final Rejection and since this appeal is based on Appellants appealing from this Final Rejection, it appears to us that the rejection had been withdrawn by the Examiner in the Final Rejection. Additionally, it has not been identified as a new ground of rejection in the Answer and even if it were, the appropriate Group Director approval is not reflected in the Answer itself. Therefore, it appears that we have no jurisdiction to consider this rejection.

Claim Groupings

Although Appellants present separate arguments to each independent claim, claims 18, 22, 27, 57, and 69, based on the features presented in these claims there are common arguments presented among them. There are no specific arguments presented as to any dependent claim within the first stated rejection. Moreover, Appellants rely for patentability of the claims in the second stated rejection upon the arguments presented with respect to those presented in the first stated rejection.

ISSUES

1. Have Appellants shown that the Examiner erred in finding that the combination of Smith and Windows 98 teaches the features common to claims 18 and 69 that an application in the disk drive controls booting in the gaming system?

2. Have Appellants shown that the Examiner erred in finding that the combination of Smith and Windows 98 teaches the inaccessibility/segregated/preventing features among independent claims 18, 22, 27, and 57?

FINDINGS OF FACT

1. Appellants' assessment of the prior art gaming systems at page 1 of the Specification indicate that gaming disks were playable in an associated disk drive within prior art gaming systems. It was noted that these gaming systems have limited internal data storage capacity and that saved game data was generally stored in a memory device external to the game console itself. On the other hand, according to the discussion at the

top of page 2 of the Specification, it was further known that a well-known video gaming system was equipped with a hard disk drive to enhance gaming that permitted significant amounts of data, including saved game data from multiple game titles and multiple users, that may be stored in such a drive that was located within the video gaming system itself.

2. The Examiner's reference to Microsoft's Windows 98 publication relates to the use of a file system and its ability to control how files and folders were stored on a hard disk drive associated with the well-known MS-DOS operating system. In addition to these features revealed at page 80 of this publication, it is stated that this disk drive was partitioned. Page 81 relates to root directories and back up files of a file allocation table (FAT) used within this file system associated with the disk operating system of MS-DOS. The Examiner further relies upon the teachings beginning at page 87 of Windows 98 of the ability to selectively share documents or not share documents utilizing the file sharing capabilities. These include the ability to choose the type of access to the folders/files as well as the use of a graphical user interface to do so.

3. From our perspective, Smith has significant teachings relating to booting functionalities associated with software associated with Smith's video gaming system as modified by the inclusion of a hard disk drive thereto. Although not apparently illustrated in Figure 2, such a boot ROM is discussed at column 9, lines 38 through 56. Such a ROM is illustrated in Figure 3 as element 182 with extensive discussions at column 12, lines 29 through 32 and column 14, lines 19 through 37. Figure 4 also illustrates boot ROM 182 and is discussed at column 15, lines 3 through 5. Further

discussions of it occur associated with Figure 10 and the discussions at column 24, lines 3 through 51.

4. Figure 1A of Smith shows a gaming system 50 that includes a game cartridge 54, a video game console 52, and an expansion device 95. The console 52 and the expansion device are illustrated in Figure 1B. The console 52 is illustrated in Figure 2 to which is attached a game cartridge 54, but the expansion device 95 is not illustrated in this Figure. Further details of it are illustrated in Figures 3 and 4. The functionalities associated with the various processors identified in or associated with the circuitry shown in Figure 2 are discussed at column 8, lines 19 through 60; column 9, lines 26 through 56 that include the discussion of a boot ROM within the interface element 138 having its own processor at column 9, lines 38 through 56; additional teachings of the relationship among the storage elements is found at column 10, lines 20 through 44 and line 52 through column 11, line 10. The discussion of Figure 3 begins at column 11, line 62 and pertinent portions include the discussion at line 67 through column 12, line 32.

5. Figure 8 of Smith depicts a memory map that appears to be associated with the hard disk drive itself to which is shown and illustrated the existence of various sectors, their buffers, the use of pointers, logical block addresses (LBA), and the use of an interrupt status register illustrated in Figure 9. Figure 10 illustrates various system software modules within the hard disk drive to include a user interface 350, an application manager 352, a communications application manager 354, an off-line application manager 356, and a file manager 360. Figure 11 also illustrates the boot ROM 182 associated with the expansion device 95 and again illustrates the hard disk drive 206.

6. From a functionality point of view regarding Smith's whole system, we make reference to the teachings at column 1, line 10 through 19; column 3, line 67 through column 4, line 3, which indicate that the hard disk drive within the expansion device 25 supports disk-based game play with both program and game data storage with a capacity of at least one gigabyte. Significant teachings are noted at column 7, lines 34 through 46, that indicate various types of files may be stored on the hard disk drive. Further significant teachings are noted at column 13, lines 3 through 38. It is stated at lines 9 through 11 that "[m]ass storage device 174 stores a network browser program, the expansion device operating system, and all expansion device application programs." Subsequent lines indicate again the ability to store different information downloaded to it from Internet sources to include data and other application programs. It is further noted at lines 14 through 17 that this mass storage device has associated with it its own disk controller within interface logic 178. Most significant is the teaching at column 13, lines 18 through 20 that state "[b]oth the disk controller and modem controller, for example, have access to the same video game system 52 RAM/ROM space to form a unified memory structure." With respect to the showing in Figure 10, the discussion at column 22, line 66, through column 23, line 20 is pertinent to the functionality of the illustrated system software modules in Figure 10 which includes, significantly, a file manager module 360 where it is stated at lines 15 through 17 that it "controls the files which are stored on hard drive 206 or other mass memory module utilized in the system." Lastly, we make reference to the discussion at column 24, line 62 through column 25, line 22 that again emphasizes the nature of the applications and data that may be stored on the hard disk drive within

Smith's gaming system to indicate as well that the application manager 352 in Figure 10 controls the storing and transferability of application programs within the hard disk drive 206.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

The Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417. The Court noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of

ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420.

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Dovetailing with this precedent, we note further that the test for obviousness has been further characterized as not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the

combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Young*, 927 F.2d at 591.

The prior art relied on to prove obviousness must be analogous art. As explained in *Kahn*,

the “analogous-art” test . . . has long been part of the primary *Graham* [v. *John Deere Co.*, 383 U.S. 1 (1966)] analysis articulated by the Supreme Court. *See Dann* [v. *Johnston*], 425 U.S. [219,] at 227-29 [(1976)]; *Graham*, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d. 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’ in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

Kahn, 441 F.3d at 986-87. *See also In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”).

ANALYSIS

A major part of the principal Brief and the bulk of the Reply Brief address the alleged impropriety of the combinability of Smith with Windows 98. As the earlier-noted case law well documents, despite Appellants’

characterization of the Examiner's reasons for combinability as being weakly-based, we find the Examiner's reasoning as well as the additional reasoning we advance here meet the standards of combinability for the respective teachings of Smith and Windows 98. An artisan's studied consideration of the teachings we noted among Findings of Fact 1 through 6 belie a persuasive argument of hindsight combinability. There is also no requirement for motivation of combinability according to the earlier-noted case law even though it is permitted.

Whatever weaknesses may be in the Examiner's reasoning for the combinability of Smith and Windows 98 at page 8 of the Answer, detailing the Examiner's rationale in the initial statement of the rejection, there are significantly expanded rationales beginning in the responsive arguments at page 11. As admitted by Appellants as we noted in Finding of Fact 1, the assignee of the present application marketed a gaming system utilizing a hard disk drive that apparently had some file management capabilities because it stored internally large amounts of different types of data which obviously had to be managed in a non-interfering manner. Appellants' own assignee also developed the so-called disk operating system reflected in Windows 98 as MS-DOS. Appellants did not identify in their own Specification as filed any known operating system or file management software by which to perform the file management functions that are reflected in the independent claims on appeal.

Although the Examiner did not identify significant teachings in Smith that we have outlined among our Findings of Fact 3 through 6, we emphasize that among these findings there is a specific teaching in our referenced discussion of column 13 that the mass storage device 174 stored

an operating system on it and that the memory spaces identified in the complete system were said to form a “unified memory structure.” Smith, col. 13, l. 20. These findings are in addition to what the artisan would understand from the brief discussion of the disk operating system in Windows 98 we excerpted from this reference into Finding of Fact 2. Although Smith does not identify any specific prior art operating system (OS) (or DOS) resident on his hard disk, one is taught to be resident thereon. Windows 98’s operating system would have been an obvious choice because it was widely used in the data processing arts.

In Finding of Fact 3, we identified many locations in Smith of the use of a boot ROM that directly relates to the booting functions of independent claims 18 and 69 on appeal, which features are only argued as to independent claim 69. Traditionally, the artisan would understand that boot sectors existed according to the well-known capabilities of disk operating systems and exist therein in a read-only function.

The issues presented from the recited and argued features of the claims appear to be no more than a simple arrangement of old elements, with each performing the same function it had been known in the art to perform, yielding no more than one would expect from such an arrangement. *See KSR*, 550 US at 417. An artisan is also a person of ordinary creativity, not an automaton (*Id* at 421), and that common sense of the artisan would find such arrangements to be obvious without hindsight, contrary to Appellants’ contentions in the Brief and Reply Brief. *Id.* Appellants also have not shown the claimed combinations were uniquely challenging or difficult for one of ordinary skill in the art. *See Leapfrog Enters., Inc.*, 485 F.3d at 1161 (Fed Cir. 2007) (citing *KSR*, 550 US at 415 (2007)).

The manner in which Smith's overall system functions as we indicated in Finding of Fact 4 reflects a data management capability of both plural game application data and (user) game data for plural games associated with those applications within his system as well as with the ability to do so within the hard disk drive of Smith itself. The file management capabilities of Windows 98 from Finding of Fact 2 dovetail with the identified file managing capabilities we noted with respect to the showing in Figures 8 through 10 in Finding of Fact 5, as well as the extensive discussion of them in Finding of Fact 6. In the same manner that Appellants' disk drive in Figure 4 has been partitioned by an unknown operating system into the various identified portions or regions, it was well-known in the art that disk operating systems (DOS) and the file managers associated with them from Windows 98 and from the identified functionality in Smith, all function to permit the inaccessibility of one file by another file, and avoiding the mixing of data associated with one file with that of another file, file segregation, and otherwise stated, the preventing of mixing of file data of one named file with another named file as reflected among independent claims 18, 22, 27, and 57. Additionally, the teachings of the sharing capabilities required in independent claim 57 are well justified as being met by the Examiner's teachings of selective file sharing associated with Windows 98 we identified in Finding of Fact 2.

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in finding that the combination of Smith and Windows 98 teaches the software booting requirement of independent claims 18 and 22 on appeal (issue 1) and have

not shown that the Examiner erred in finding that the combination of Smith and Windows 98 teaches the inaccessible, segregated, and preventing functions among independent claims 18, 22, 27, and 57 on appeal.

DECISION

The Examiner's initial rejection of claims 18, 20 through 25, 27 through 35, 57, 58, 60, and 69 through 71 as being obvious within 35 U.S.C. § 103 over Smith in view of Windows 98 is affirmed. Likewise, the second stated rejection of dependent claims 26, 32, and 33 also under 35 U.S.C. § 103 over the collective teachings of Smith in view of Windows 98, further in view of Links is also affirmed. All claims on appeal are unpatentable.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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